

Serial No. 09/653,735
Attorney Docket No. 65678-0032

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: SUHY

Serial No.: 09/653,735


Group Art Unit: 3621

Filed: 09/01/2000

Examiner: HEWITT II, Calvin L.

For: APPARATUS AND METHOD FOR TRACKING AND
MANAGING PHYSICAL ASSETS

Attorney Docket No.: 65678-0032

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8(a))	
I hereby certify that this correspondence is, on the date shown below, being:	
<input type="checkbox"/> deposited with the United States Postal Service	<input checked="" type="checkbox"/> transmitted by facsimile to the Patent and Trademark Office to Examiner Calvin L. Hewitt II at 703-305-7687.
_____ first class mail, postage prepaid in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
Date: October 10, 2003	 _____ Signature (Sarah J. Goodwin)

**PETITION UNDER 37 C.F.R. § 1.181
TO REQUEST WITHDRAWAL OF
THE FINAL OFFICE ACTION OF AUGUST 12, 2003**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby petitions for withdrawal of finality of the Office Action mailed in the above-identified application on August 12, 2003 as Paper No. 9 ("Office Action"). This is a petitionable issue because Applicant seeks review of the prematurity of the final rejection within the Office Action. MPEP 706.07(c).

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Serial No. 09/653,735
Attorney Docket No. 65678-0032

I. INTRODUCTION

Claims 1-8 and 12-24 are currently pending. In the Office Action: claims 1-7 and 12-24 were rejected under 35 U.S.C. 103(a) as being obvious over US Patent No. 5,875,430 ("Koether") in view of US Patent No. 6,230,081 ("Albertshofer"); and claim 8 was rejected under 35 U.S.C. 103(a) as being obvious over Koether and Albertshofer as applied to claim 1, and further in view of US Patent No. 6,003,808 ("Nguyen").

By way of a Request for Reconsideration filed concurrently with this Petition, applicant has respectfully traversed the examiner's rejections and submit that all pending claims are in condition for allowance. Applicants further respectfully requested in the alternative that the Office withdraw the finality of the Office Action and reopen prosecution of the present application.

Applicant advances two independent reasons why the Office Action was improperly made final: (1) the examiner did not respond at all to a number of applicant's arguments traversing the examiner's rejections and therefore there are issues between the examiner and the applicant that are not ripe for appeal, and (2) the examiner's rejections of the claims, as currently stated, are not sufficiently detailed so as to make the issues between the examiner and the applicant sufficiently developed for appeal.

II. ARGUMENTS

As a rule, "assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference." (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982). "Allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge." (Citations omitted). *Id.* Further, the support must have existed at the time the claimed invention was made. *In re Merck & Co., Inc.*, 231 USPQ 375, 379 (Fed. Cir. 1986).

Serial No. 09/653,735
Attorney Docket No. 65678-0032

The issues submitted for review are appropriate subject matter for a petition to the Commissioner because they are entirely procedural and, as provided for in 37 CFR 1.181(a)(1), are "not subject to appeal to the Board of Patent Appeals and Interferences or to the court." Applicant is not, in this petition, challenging the substance of the examiner's rejections but rather is arguing that the examiner did not follow proper procedure by not responding to all of applicant's arguments traversing those rejections and by not stating the rejections in enough detail to enable applicant to respond to them.

A. THE EXAMINER'S FAILURE TO RESPOND TO ALL OF APPLICANT'S ARGUMENTS REQUIRES WITHDRAWAL OF FINALITY.

There can be no debate that the examiner has a clear duty to specifically respond to each of applicants' arguments, and that the examiner must do so before an action can properly be made final. Section 706.07 of the MPEP clearly states that

Before final rejection is in order a clear issue should be developed between the examiner and applicant. . . . The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

Moreover, Section 706.07 states that the final rejection "should include a rebuttal of any arguments raised in the applicant's reply" to the examiner's last rejections. Similarly, MPEP 707.07(f) states that "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."

In the Remarks filed July 14, 2003 applicant made a number of arguments to which the final Office Action wholly failed to respond. These arguments include the following:

- The prior art of record does not teach a plurality of operating characteristics used to set the lease rate as recited in claim 5. (Page 11, lines 19-21.)
- The prior art of record does not teach using maintenance information to affect lease rate as recited in claims 7, 18, 21, and 22. (Page 12, lines 2-3 and lines 17-19.)
- The prior art of record does not teach a hybrid lease arrangement as recited in claim 22. (Page 12, lines 26-27.)

Serial No. 09/653,735
Attorney Docket No. 65678-0032

- Claim 20 should be rejected on the same grounds as claim 8, inasmuch as these claims contain similar limitations. (Page 13, lines 4-6.)
- US Patent No. 6,003,808 to Nguyen merely teaches the generation of a warranty claim for a particular asset and as such is wholly irrelevant to applicant's claims. (Page 13, line 7.)
- The examiner ignored applicant's request, originally made on page 11 of the Remarks filed July 14, 2003, for a supporting affidavit or an appropriate reference in the context of the claimed invention if the Examiner is going to maintain the rejection of any claims based on Official Notice.

As is clear from the instances cited in the preceding paragraph, the record contains issues inadequately developed for appeal because the examiner has left the record silent regarding the examiner's position and reasoning with respect to a number of issues material to the rejection of applicant's claims. For example, although claim 5 stands rejected, nowhere does the examiner explain how the prior art of record teaches a plurality of operating characteristics used to set the lease rate as recited in claim 5. Thus, in preparing an appeal, applicant has no basis on which to respond to the examiner's reasoning in applying the prior art of record to claim 5, because that reasoning has not been revealed anywhere in the record. To take another example, in failing to respond to applicant's argument that claims 8 and 20 contain similar subject matter, the examiner has left the record confused as to the grounds of rejection for claim 20.

Again, applicant is not, in this petition, challenging the substance of the Office Action's rejection. Applicant is not suggesting that the reviewer of this petition needs to become acquainted with the substance of applicant's claims. Rather, the above examples are intended to illustrate instances in which applicant cannot be certain if the examiner is employing implicit reasoning, is implicitly taking Official Notice of facts necessary to support the rejection, or is simply ignoring some of applicant's claim limitations and the arguments regarding those claim limitations.

The procedures established by Title 37 of the Code of Federal Regulations expressly entitle the applicant to an Examiner's affidavit upon request. Specifically, "when a rejection in an application is based on facts within the personal knowledge of an

Serial No. 09/653,735
Attorney Docket No. 65678-0032

employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." 37 CFR 1.104(d)(2). In addition, the failure to provide any objective evidence to support the challenged use of Official Notice constitutes clear and reversible error. *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989).

Applicant submits that the above-described holes in the record leave issues that are inadequately developed for appeal. Therefore, applicant respectfully submits that finality in this case was premature, and prosecution should be reopened.

B. THE "OMNIBUS" REJECTION OF CLAIMS 1-7 AND 12-24 REQUIRES WITHDRAWAL OF FINALITY.

The examiner rejected claims 1-7 and 12-24 under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,875, 430 ("Koether") in view of U.S. Patent No. 6,230,081 ("Albertshofer"). All of these claims were rejected together in a single paragraph that fails to separately identify each claim and its limitations, and fails to state how the prior art of record applies to each limitation of each claim. Instead, the Office Action on page 4 provides a list of disclosures by Koether without identifying the claim limitations on which the examiner believes each of these disclosures reads. None of the listed disclosures matches limitations in applicant's claims. In sum, the examiner has left it to applicant to guess which claim limitation is being rejected by the listing of a given statement in the Office Action.

As an example, in the paragraph rejecting claims 1-7 and 12-24 under 35 USC 103(a) as being unpatentable over Koether in view of Albertshofer, the Office Action on pages 4 offers the following statements, without stating the claims or limitations to which the statements apply:

Regarding surcharges (claims 2-4), the Examiner takes Official Notice that surcharges and the appliance of surcharges are old and well-known to those of ordinary skill in the art. Koether also teaches transmitting data (Figures 1-3). Therefore, it would have been obvious to transfer data by any means (e.g. real-time, "almost" real time, batch, sequentially, push, pull) in order to implement corporate policy and produce a desired result. However, Koether doesn't explicitly recite determining a lease rate. Albertshofer

Serial No. 09/653,735
Attorney Docket No. 65678-0032

teaches an asset usage monitoring system that monitors asset performance (e.g. plurality of characteristics over a fixed period of time, maintenance information) to determine a leasing rate (column 1, lines 55-61; column 2, lines 36-44, column 3, lines 31-39; column 4, lines 10-26; column 6, lines 23-27 and 40-50) and assets that are limited in motion to a pre-determined geographic region (figure 1; column 4, lines 30-37. Further, Webster's Ninth Collegiate Dictionary defines a "rate" as "a quantity, amount, or degree of something measured per unit of something else" or "an amount of payment or charge based on another amount". Therefore, it would have been obvious to calculate a rate based on any quantity, amount, or degree of something within the scope of knowledge and understanding of one of ordinary skill in the appropriate art, such as owners of equipment who also maintain the equipment that they lease to others. Therefore, it would have been obvious to one of ordinary skill to combine the systems of Koether and Albertshofer in order to accurately determine fees for the rental or leasing of capital equipment.

It appears that the examiner intended many of the listed disclosures to be combined with disclosure from Albertshofer or the examiner's taking of Official Notice. However, because of the examiner's failure to identify specific claims, much less specific claim limitations, to which the prior art of record is being applied, it is impossible for applicant to determine what the Office believes to be the basis for an obviousness rejection of each claim. In particular, the examiner has not adequately explained what combination of elements from each cited reference would have rendered each recited claim limitation obvious. Applicant respectfully submits that if the applicant cannot determine the grounds of each rejection, then certainly the record is not sufficiently developed for appeal.

Accordingly, applicant respectfully submits that for this second, independent reason, finality in this case was premature, and prosecution should be reopened.

Serial No. 09/653,735
Attorney Docket No. 65678-0032

IV. CONCLUSION

The rejection of claims 1, 3, 5-13, and 15-21 in the Office Action was improperly made final. Accordingly, applicant hereby petitions the Commissioner to withdraw the finality of the Office Action, and to respond with either a Notice of Allowability or a non-final Office Action.

It is believed that any additional fees due with respect to this paper have already been identified in any transmittal accompanying this paper. However, if any additional fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge account number 18-0013 in the name of Rader, Fishman and Grauer PLLC.

Respectfully submitted,

Date: October 10, 2003

By: 

Michael B. Stewart, Reg. No. 36,018
Charles A. Bieneman, Reg. No. 51,472
Rader Fishman and Grauer PLLC
39533 Woodward Ave, Suite 140
Bloomfield Hills, Michigan 48304
Attorneys for Applicant

Customer No. 010291

Telephone Number (248) 594-0648